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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,923	05/15/2001	Margaret P. Opolski	112280-121US CN	4361

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HALE AND DORR, LLP  
60 STATE STREET  
BOSTON, MA 02109

EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

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DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/855,923

Applicant(s)

OPOLSKI, MARGARET P.

Examiner

Judy M. Reddick

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 5/15/01;6/25/01;3/5/02;11/13/02;2/11/02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-19 and 28-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 & 7. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

**1. Applicant's election of the Group II invention/acrylic copolymer/poly(vinylpyrrolidone)/aziridines/water-contacting items species in Paper No. 8(12/11/02) is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).**

***Information Disclosure Statement***

**2. The information disclosure statements filed 03/05/02 & 11/13/02 have been considered and placed in the application file.**

***Claim Objections***

**3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).**

**Misnumbered claims 12-21, 22-28(now cancelled) and 29-31 have been renumbered 11-20, 21-27(now cancelled) and 28-30. Applicant is herein advised that the claims dependency has been also corrected by the Examiner. However, applicant is kindly requested to review the record so as to ensure that the claim**

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***amendments and claim cancellations are made consistent with the renumbered claims via Rule 1.126.***

***Claim Rejections - 35 USC § 112***

***4. The following is a quotation of the second paragraph of 35 U.S.C. 112:***

***The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.***

***5. Claims 14-19 and 28-30(renumbered) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.***

***A) The recited "said supporting polymer forming a three-dimensional network" and "said coating characterized in that the supporting polymer forms a three-dimensional network" per claim 14 constitutes indefinite subject matter as such engenders redundant subject matter.***

***B) The recited "minimizes eliminates dissociation" per claim 14 constitutes indefinite subject matter as per it not being readily ascertainable as to how said actions can be performed simultaneously VS alternatively.***

***C) Claim 14, in its entirety, engenders unclear and confusing subject matter.***

***D) The recited "polyethylene and polypropylene copolymers" per claim 15 constitutes indefinite subject matter as per it not being clear if applicant intends copolymers of polyethylene and copolymers of polypropylene" or "ethylene-propylene copolymers".***

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**E) The recited “polyvinyl chlorides, epoxides” per claim 15 and “epoxides, polyvinyl chlorides” per claim 30 constitutes indefinite subject matter as per a) the plural form of “chlorides” and b) it is not readily ascertainable as to how the recited “epoxides” further limits the antecedently recited “polymer”.**

**F) The recited “wherein the hydrophobic polymer is selected from the group consisting of poly(N-vinyl lactams, poly(vinyl pyrrolidone) poly(ethylene oxide) polypropylene oxide) polyacrylamides, cellulosics, methyl cellulose” per claim 16 constitutes indefinite subject matter as per it not being readily ascertainable, based on missing commas and misplaced parenthesis, as to the exact members of the Markush selection. Further, it is not clear as to how “cellulosics” differentiates over “methyl cellulose” and “poly(N-vinyl lactams)” over poly(vinyl pyrrolidone)”.**

**G) The recited “wherein the crosslink density” per claim 17 constitutes indefinite subject matter as per the non-express establishment of proper antecedent basis.**

**H) The recited “moieties of aziridines---unsaturated carbon and hetero bonds, ionic agents” per claim 18 constitutes indefinite subject matter as per the metes and bounds of such engender an indeterminacy in scope.**

**I) The recited “melamine/urea condensates” per claim 18 constitutes indefinite subject matter as per it not being readily ascertainable as to the intended meaning of the “/”.**

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**J) The recited "recreational product" per claim 19 constitutes indefinite subject matter as per the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).**

**K) The recited "water-contacting items" per claim 19 constitutes indefinite subject matter as per the metes and bounds of such engendering an indeterminacy in scope.**

**L) The recited "associated with the polyacrylate network" per claims 28 and 29 constitute indefinite subject matter as per a) it is not readily ascertainable as to how the recited "the polyacrylate polymer" further limits the antecedently recited "polyacrylates and polymethacrylates"; b) the non-express establishment of proper antecedent basis; c) the metes and bounds of "associated with", in this context, engender an indeterminacy in scope.**

**M) The recited "polyethylene and polypropylene co-difunctional polymers-----alkyl copolymers" per claim 30 engenders and indeterminacy in scope. It is not readily ascertainable as to the intended meaning of said polymers and copolymers.**

**N) The recited "associated with the polymer matrix" per claim 30 constitutes indefinite subject matter as per the same reasons given in item K).**

#### **Double Patenting**

**6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.**

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**See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (F. d. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).**

**A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).**

**Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).**

**7. Claims 14-19 and 28-30(elected invention) are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,238,799 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed invention generically encompasses the claimed invention of U.S.'799.**

#### **Claim Rejections - 35 USC § 102**

**8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

**A person shall be entitled to a patent unless –**

**(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.**

**9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

**(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if th**

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***differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.***

**10. Claims 14-19 and 28-30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Opolski(U.S. 5,272,012).**

*Opolski teaches medical articles coated with a protective, lubricious, aqueous coating composition defined basically as containing a protective compound such as a urethane resin, acrylic resins, vinylidene chlorides and vinyls, a slip additive which may be hydrophilic or hydrophobic and includes polyvinyl pyrrolidone copolymers and other lactams and, optionally, a crosslinking agent such as an aziridine, carbodiimide, etc. See, e.g., the Abstract, col. 2, lines 1-68 and col. 3, lines 1-10 of Opolski. More specifically, Opolski exemplifies an aqueous coating composition, applied to a balloon catheter, and defined basically as containing an aqueous acrylic or urethane resin dispersion, a polyvinylpyrrolidone, Aziridine and water. See, Runs 2 and 5. Opolski therefore anticipate the instantly claimed invention with the understanding that one of ordinary skill in the art would have readily envisaged the use of a lactam such as polyvinyl pyrrolidone in lieu of or in addition to the Dimethyl Siloxane component per Run 2, following the guidelines of their disclosed scope equivalency per col. 2, lines 40-57 of Opolski. By the same token, one of ordinary skill in the art would have readily envisaged the use of an acrylic resin in lieu of or*



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*in addition to the Urethane component per Run 5, following the guidelines of Opolski at col. 2, lines 24-39.*

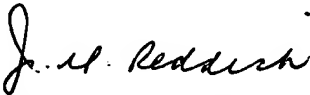
***As to the dependent claims, the limitations are either taught by Opolski, suggested by Opolski or would have been obvious to the skilled artisan and with a reasonable expectation of success.***

**Conclusion**

***Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..***

***If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.***

***Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.***

  
**Judy M. Reddick  
Primary Examiner  
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**JMR** *Jmr*

**December 15, 2002**